

10-19-01

Attorney's Docket No. 11465.1

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Box Patent Application
Assistant Commissioner for Patents
Washington, D.C. 20231

NEW APPLICATION TRANSMITTAL

Transmitted herewith for filing is the patent application of

Inventor(s): David B. Annan, Eric K. Chan, Eddie S. DeCurtis, Teresa L. Stephens, George L. Lasota, Jr. and William J. Schaefer

For (title): A METHOD AND SYSTEM FOR WIRELESS AUDIO MESSAGE
DELIVERY

1. Type of Application

This new application is for a(n)

- ☒ Original (nonprovisional) Based on Provisional Patent Application No.: 60/240,642
filed on October 16, 2000.
- ☐ Design
- ☐ Plant
- ☐ Divisional.
- ☐ Continuation.
- ☐ Continuation-in-part (C-I-P)

CERTIFICATION UNDER 37 CFR 1.10

I hereby certify that this New Application Transmittal
and the documents referred to as enclosed therein are
being deposited with the United States Postal Service

on this date October 16, 2001, in an envelope as
"Express Mail Post Office to Addressee" Mailing
Label Number EL 228 703 336 US, addressed to the:
Assistant Commissioner for Patents, Washington,
D.C. 20231.

Lorraine Gloria
(Lorraine Gloria)

2. Benefit of Prior U.S. Application(s) (35 U.S.C. 119(e), 120, or 121)

- ☒ This new application being transmitted claims the benefit of prior U.S. application(s). Enclosed are ADDED PAGES FOR NEW APPLICATION TRANSMITTAL WHERE BENEFIT OF PRIOR U.S. APPLICATION(S) CLAIMED.

2. Papers Enclosed That Are Required for Filing Date under 37 C.F.R. 1.53(b) (Regular) or 37 C.F.R. 1.153 (Design) Application

<u>16</u>	Pages of Specification
<u>8</u>	Pages of claims
<u>1</u>	Pages of Abstract
<u>5</u>	Sheets of drawings

- ☒ formal
- ☐ informal
- ☐ The enclosed drawing(s) are photograph(s), and there is also attached a "PETITION TO ACCEPT PHOTOGRAPH(S) AS DRAWINGS." 37 C.F.R. 1.84(b).

3. Additional papers enclosed

- ☐ Preliminary Amendment
- ☐ Information Disclosure Statement (37 C.F.R. 1.98)
- ☐ Form PTO-1449 (PTO/SB/08A and 08B)
- ☐ Citations
- ☐ Declaration of Biological Deposit
- ☐ Submission of "Sequence Listing," computer readable copy and/or amendment pertaining thereto for biotechnology invention containing nucleotide and/or amino acid sequence.
- ☐ Authorization of Attorney(s) to Accept and Follow Instructions from Representative
- ☐ Special Comments
- ☐ Other-

4. Declaration or oath

☒ Enclosed is an **unexecuted** original declaration/power of attorney

Executed by

☐ inventor(s).

☐ legal representative of inventor(s).
37 C.F.R. 1.42 or 1.43.

☐ joint inventor or person showing a proprietary interest on behalf of inventor who refused to sign or cannot be reached.

☐ This is the petition required by 37 CFR 1.47 and the statement required by 37 CFR 1.47 is also attached. *See item 13 below for fee.*

☐ Not Enclosed.

☐ Application is made by a person authorized under 37 CFR 1.41(c) on behalf of *all* the above named inventor(s).

(The declaration or oath, along with the surcharge required by 37 CFR 1.16(e) can be filed subsequently).

☐ Showing that the filing is authorized.
(not required unless called into question. 37 CFR 1.41(d))

5. Inventorship Statement

The inventorship for all the claims in this application are:

☒ The same.

or

☐ Not the same. An explanation, including the ownership of the various claims at the time the last claimed invention was made.

☐ is submitted.

☐ will be submitted.

6. Language

☒ English

☐ Non-English

☐ The attached translation is a verified translation. 37 C.F.R. 1.52(d).

7. Assignment

☒ An assignment of the invention

☒ is attached. A separate ☒ "COVER SHEET FOR ASSIGNMENT (DOCUMENT) ACCOMPANYING NEW PATENT APPLICATION" or ☒ FORM PTO 1595 is also attached.

☐ will follow.

☐ The prior application is assigned to _____, recorded at reel/frame numbers _____.

8. Certified Copy

Certified copy(ies) of application(s)

Country	Appln. no.	Filed
Country	Appln. no.	Filed
Country	Appln. no.	Filed

from which priority is claimed

☐ is (are) attached.

☐ will follow.

9. Fee Calculation (37 C.F.R. 1.16)

A. ☐ Regular application

CLAIMS AS FILED					
Number filed			Number Extra	Rate	Basic Fee 37 C.F.R. 1.16(a) \$370.00
Total					
Claims (37 CFR 1.16(c))	27	- 20 =	7	x \$ 9.00 =	\$63.00
Independent					
Claims (37 CFR 1.16(b))	4	- 3 =	1	x \$ 42.00 =	\$42.00
Multiple dependent claim(s), if any (37 CFR 1.16(d))				+ \$ 270.00 =	

- ☐ Amendment cancelling extra claims is enclosed.
- ☐ Amendment deleting multiple-dependencies is enclosed.
- ☐ Fee for extra claims is not being paid at this time.

Filing Fee Calculation \$475.00

B. ☐ Design application
(\$330.00 - 37 CFR 1.16(f))

Filing Fee Calculation \$

C. ☐ Plant application
(\$530.00 - 37 CFR 1.16(g))

Filing Fee Calculation \$

10. Small Entity Statement(s)

☐ Verified Statement(s) that this is a filing by a small entity under 37 CFR 1.9 and 1.27 ☐ is (are) attached . ☐ will follow.

☒ Status as a small entity was claimed in prior application
60/240,642 filed on October 16, 2000, from which benefit
is being claimed for this application under:

35 U.S.C. ☒ 119(e),
☐ 120,
☐ 121,
☐ 365(c),

and which status as a small entity is still proper and desired.

☒ A copy of the verified statement in the prior application is included.

Filing Fee Calculation (50% if A, B or C above) \$ 475.00

11. Request for International -- Type Search (37 C.F.R. 1.104(d))

(complete, if applicable)

☐ Please prepare an international-type search report for this application at the time when national examination on the merits takes place.

09517-101601
109107-221550

12. Fee Payment Being Made at This Time

☐ Not Enclosed

☐ No filing fee is to be paid at this time.
(This and the surcharge required by 37 C.F.R. 1.16(e) can
be paid subsequently.)

☐ Enclosed

☐ Basic filing fee \$ 475.00

☐ Recording assignment (\$40.00; 37 C.F.R. 1.21(h))
(See attached "COVER SHEET FOR ASSIGNMENT
ACCOMPANYING NEW APPLICATION".) \$ 40.00

☐ Petition fee for filing by other than all the inventors or
person on behalf of the inventor where inventor refused to
sign or cannot be reached (\$130.00; 37 C.F.R. 1.52(d) and 1.17(k)) \$

☐ For processing an application with a specification in a non-
English language (\$130.00; 37 C.F.R. 1.52(d) and 1.17(k)) \$

☐ Processing an retention fee (\$130.00; 37 C.F.R. 1.53(d) and 1.21(l)) \$

☐ Fee for international-type search report (\$40.00; 37 C.F.R. 1.21(e)) \$

Total fees enclosed \$ 515.00

13. Method of Payment of Fees

☐ Checks in the amount of .

☒ Charge Account No. 15-0665 in the amount of \$ 475.00 and \$40.00.

☒ A duplicate of this transmittal is attached.

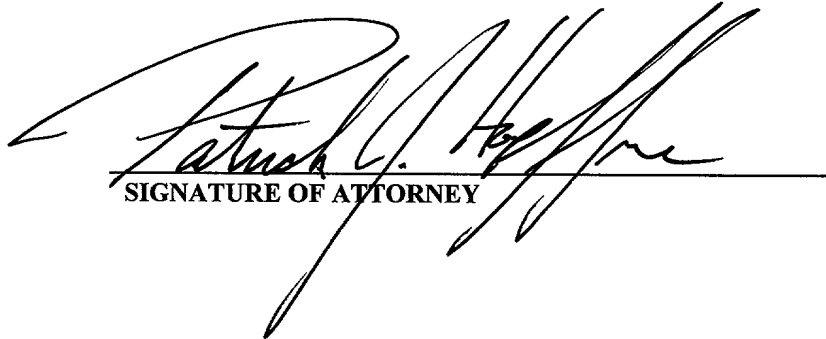
14. Authorization to Charge Additional Fees

- ☒ The Commissioner is hereby authorized to charge the following additional fees required by this paper and during the entire pendency of this application to Account No. 15-0665.
- ☒ 37 C.F.R. 1.16(a), (f) or (g) (filing fees)
- ☒ 37 C.F.R. 1.16(b), (c) and (d) (presentation of extra claims)
- ☒ 37 C.F.R. 1.16(e) (surcharge for filing the basic filing fee and/or declaration on a date later than the filing date of the application)
- ☒ 37 C.F.R. 1.17 (application processing fees)
- ☐ 37 C.F.R. 1.18 (issue fee at or before mailing of Notice of Allowance, pursuant to 37 C.F.R. 1.311(b))

15. Instructions as to Overpayment

- ☒ Credit Account No. 15-0665
- ☒ Refund

Reg. No. 44,768


SIGNATURE OF ATTORNEY

(type or print name of attorney)

Tel. No. (212) 506-5000

Patrick J. Hoeffner
ORRICK, HERRINGTON & SUTCLIFFE LLP
666 Fifth Avenue
New York, New York 10103-0001

☒ **Incorporation by reference of added pages**

☒ Plus Added Pages for New Application Transmittal Where
Benefit of Prior U.S. Application(s) Claimed

Number of pages added 5

☒ Plus Added Pages for Papers Referred to in Item 4 Above

Number of pages added 6

☒ Plus "Assignment Cover Letter Accompanying New
Application"

Number of pages added 2

☐ **Statement Where No Further Pages Added**

☐ This transmittal ends with this page.

109407 224850

ADDED PAGES FOR APPLICATION TRANSMITTAL WHERE BENEFIT OF PRIOR U.S. APPLICATION(S) CLAIMED

NOTE. See 37 CFR 1.78(a).

17. Relate Back

WARNING: *If an application claims the benefit of the filing date of an earlier filed application under 35 U.S.C. 120, 121 or 365(c), the 20-year term of that application will be based upon the filing date of the earliest U.S. application that the application makes reference to under 35 U.S.C. 120, 1121 or 365(c). (35 U.S.C. 154(a)(2) does not take into account, for the determination of the patent term, any application on which priority is claimed under 35 U.S.C. 119, 365(a) or 365(b).) For a c-i-p application, applicant should review whether any claim in the patent that will issue is supported by an earlier application and, if not, the applicant should consider canceling the reference to the earlier filed application. The term of a patent is not based on a claim-by-claim approach. See Notice of April 14, 1995, 60 Fed. Reg. 20 195, at 20,205.*

(complete the following, if applicable)

- ☐ Amend the specification by inserting, before the first line, the following sentence:

A. 35 U.S.C. 119(e)

NOTE *"Any nonprovisional application claiming the benefit of one or more prior filed copending provisionals applications must contain or be amended to contain in the first sentence of the specification following the title a reference to each such prior provisional application, identifying it as a provisional application, and including the provisional application number (consisting of series code and serial number)." 37 C.F.R. § 1.78(a)(4)..*

- ☒ "This application claims the benefit of U.S. Provisional Application(s) No(s):

APPLICATION NO(S):

FILING DATE

60/240,642 _____

10/16/00 _____

/ _____

/ _____

B. 35 U.S.C. 120, 121 and 365(c)

NOTE: "Any nonprovisional application claiming the benefit of one or more prior filed copending nonprovisional applications or international applications designating the United States of America must contain or be amended to contain in the first sentence of the specification following the title a reference to each such prior application, identifying it by application number (consisting of the series code and serial number) or international application number and international filing date and indicating the relationship of the applications. Cross-references to other related applications may be made when appropriate." (See § 1.14(b)). 37 C.F.R. § 1.78(a)(2).

- ☐ "This application is a
- ☐ continuation
 - ☐ continuation-in-part
 - ☐ divisional

of copending application(s)

- ☐ application number filed on _____
- ☐ International Application _____ filed on _____ and which designated the U.S."

NOTE: The proper reference to a prior filed PCT application that entered the U.S. national phase is the U.S. serial number and the filing date of the PCT application that designated the U.S.

NOTE: (1) Where the application being transmitted adds subject matter to the International Application, then the filing can be as a continuation-in-part or (2) if it is desired to do so for other reasons than the filing can be a continuation.

- ☐ "The nonprovisional application designated above, namely application _____ / _____, filed _____, claims the benefit of U.S. Provisional Application(s) No(s):

APPLICATION NO(S):

FILING DATE

_____ / _____	_____
_____ / _____	_____
_____ / _____	_____

NOTE: The deadline for entering the national phase in the U.S. for an international application was clarified to the Notice of April 28, 1987 (1079 32 to 46) as follows:

"The Patent and Trademark Office considers the International application to be pending until the 22nd month from the priority date if the United States has been designated and no Demand for International Preliminary Examination has been filed prior to the expiration of the 19th month from the priority date and until the 32nd month from the priority date if a Demand for International Preliminary Examination which elected the United States of America has been filed prior to the expiration of the 29th month from the priority date, provided that a copy of the international application has been communicated to the Patent and Trademark Office within the 20 or 30 month period respectively. If a copy of the international application has not been communicated to the Patent and Trademark Office within the 20 or 30 month period respectively, the international application becomes abandoned as to the United States 20 or 30 months from the priority date respectively. These periods have been placed in the rules as paragraph (h) of § 1.494 and paragraph (i) of § 1.495. A continuing application under 35 U.S.C. 365(c) and 120 may be filed anytime during the pendency of the international application."

18. **Relate Back—35 U.S.C. 119 Priority Claim for Prior Application**

The prior U.S. application(s), including any prior International Application designating the U.S., identified above in item 17B, in turn itself claim(s) foreign priority(ies) as follows:

Country	Appln. no.	Filed on
---------	------------	----------

The certified copy(ies) has (have)

- ☐ been filed on _____, in prior application _____ / _____, which was filed on _____.
- ☐ is (are) attached.

WARNING: *The certified copy of the priority application that may have been communicated to the PTO by the International Bureau may not be relied on without any need to file a certified copy of the priority application in the continuing application. This is so because the certified copy of the priority application communicated by the International Bureau is placed in a folder and is not assigned a U.S Serial number unless the national stage is entered. Such folders are disposed of if the national stage is not entered. Therefore, such certified copies may not be available if needed later in the prosecution of a continuing application. An alternative would be physically remove the priority documents from the folders and transfer them to the continuing application. The resources required to request transfer, retrieve the folders, make suitable record notations, transfer the certified copies, enter and make a record of such copies in the Continuing Application are substantial. Accordingly, the priority documents in folders of international applications that have not entered the national stage may not be relied on. Notice of April 28, 1987 (1079 O.G. to 46).*

19. **Maintenance of Copendency of Prior Application**

NOTE: *The PTO finds it useful if a copy of the petition filed in the prior application extending the term for response is filed with the papers constituting the filing of the continuation application. Notice of November 5, 1985 (1060 O.G. 27).*

- A. ☐ Extension of time in prior application

(This item must be completed and the papers filed in the prior application, if the period set in the prior application has run.)

- ☐ A petition, fee and response extends the term in the pending **prior** application until _____.

- ☐ A **copy** of the petition filed in prior application is attached.

- B. ☐ .Conditional Petition for Extension of Time in Prior Application

(complete this item, if previous item not applicable)

- ☐ A conditional petition for extension of time is being filed in the pending **prior** application.

- ☐ A **copy** of the conditional petition filed in the prior application is attached.

20. Further Inventorship Statement Where Benefit of Prior Application(s) Claimed

NOTE: "If the continuation, continuation-in-part, or divisional application is filed by less than all the inventors named in the prior application a statement **must** accompany the application when filed requesting deletion of the names of the person or persons who are not inventors of the invention being claimed in the continuation, continuation-in-part, or divisional application." 37 CFR . 1.62(a) [emphasis added] (dealing with the file wrapper continuation situation).

NOTE: "In the case of a continuation-in-part application which adds and claims additional disclosure by amendment, an oath or declaration as required by § 1.63 must be filed. In those situations where a new oath or declaration is required due to additional subject matter being claimed, additional inventors may be named in the continuing application. In a continuation or divisional application which discloses and claims only subject matter disclosed in a prior application, no additional oath or declaration is required and the application must name as inventors the same or less than all the inventors in the prior application." 37 CFR 1.62(c) (dealing with the continuation situation).

(complete applicable item (a), (b) and/or (c) below)

- (a) ☐ This application discloses and claims only subject matter disclosed in the prior application whose particulars are set out above and the inventor(s) in this application are

☐ the same.

☐ less than those named in the prior application. It is requested that the following inventor(s) identified for the prior application be deleted:

(type name(s) of inventor(s) to be deleted)

- (b) ☐ This application discloses and claims additional disclosure by amendment and a new declaration or oath is being filed. With respect to the prior application, the inventor(s) in this application are

☐ the same.

☐ the following additional inventor(s) have been added:

(type name(s) of inventor(s) to be deleted)

- (c) ☐ The inventorship for all the claims in this application are

☐ the same.

☐ not the same. An explanation, including the ownership of the various claims at the time the last claimed invention was made

☐ is submitted.

☐ will be submitted.

21. **Abandonment of Prior Application (if applicable)**

- ☐ Please abandon the prior application at a time while the prior application is pending, or when the petition for extension of time or to revive in that application is granted, and when this application is granted a filing date, so as to make this application copending with said prior application.

NOTE:: According to the Notice of May 13, 1983 (103, TMOG 6-7), the filing of a continuation or continuation-in-part application is a proper response with respect to a petition for extension of time or a petition to revive and should include the express abandonment of the prior application conditioned upon the granting of the petition and the granting of a filing date to the continuing application.

22. **Petition for Suspension of Prosecution for the Time Necessary to File an Amendment**

WARNING: "The claims of a new application may be finally rejected in the first Office action in those situations where (1) the new application is a continuing application of, or a substitute for, an earlier application, and (2) all the claims of the new application (a) are drawn to the same invention claimed in the earlier application, and (b) would have been properly finally rejected on the grounds of art of record in the next Office action if they had been entered in the earlier application," MPEP, § 706.07(b).

NOTE: Where it is possible that the claims on file will give rise to a first action final for this continuation application and for some reason an amendment cannot be filed promptly (e.g., experimental data is being gathered) it may be desirable to file a petition for suspension of prosecution for the time necessary.

(check the next item, if applicable)

- ☐ There is provided herewith a Petition To Suspend Prosecution for the Time Necessary to File an Amendment (New Application Filed Concurrently)

23. **Small Entity (37 CFR § 1.28(a))**

- ☒ Applicant has established small entity status by the filing of a verified statement in provisional application 60/240,642 filed on October 16, 2000.
- ☒ A copy of the verified statement previously filed is included.

WARNING: See 37 CFR § 1.28(a).

24. **NOTIFICATION IN PARENT APPLICATION OF THIS FILING**

- ☐ A notification of the filing of this
(check one of the following)
- ☐ continuation
 - ☐ continuation-in-part
 - ☐ divisional

is being filed in the parent application, from which this application claims priority under 35 U.S.C. § 120.